REMARKS

Summary of the Office Action

In the Office Action, Figs. 2 and 3 are objected to because "GROOVE" and "LAND" have allegedly been labeled interchangeably.

Also, a new title is required.

Claims 1, 2, 12 and 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,123,003 to Noda et al. (hereinafter "Noda").

Claims 3 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Noda as applied to claims 1 and 12, and further in view of U.S. Patent No. 6,545,959 to Iida (hereinafter "Iida").

Claims 9 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Noda as applied to claims 1 and 12, and further in view of U.S. Patent No. 5,959,953 to Alon (hereinafter "Alon").

Claims 10, 11, 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Noda as applied to claims 1 and 12, and further in view of U.S. Patent No. 5,404,344 to Imada et al. (hereinafter "Imada").

Claims 4-8 and 15-17, while objected to as being dependent upon a rejected base claim, would be allowable if rewritten in independent form.

Summary of the Response to the Office Action

In accordance with the requirement for a new title, the title has been amended as a new title. Claims 1-20 currently remain pending for consideration.

Requirement for a new Title

The Office Action alleges that the title is "not descriptive" and thus requires a new title. In response, Applicants have amended the title in accordance with the Office Action's requirement. Accordingly, withdrawal of the requirement for a new title is respectfully requested.

Objection to Figs. 2 and 3

Figs. 2 and 3 are objected to because "GROOVE" and "LAND" have allegedly been labeled interchangeably. The Office Action asserts that "[t]he exposed part is normally known in the art as the "LAND" and the recessed part is normally known as the "GROOVE." Accordingly, the Office Action states that the "drawings need to be corrected accordingly."

Applicants respectfully traverse the objection and associated drawing correction requirement because the drawings are technically accurate in their current form. Applicants note in this regard that this same issue was raised by another Examiner during the prosecution of U.S. Application No. 09/898,488, which has now issued as U.S. Patent No. 6,618,350 (a copy of which is attached hereto as Exhibit A). The Examiner's inquiry in that previous application did not rise to the level of an official objection, however. Instead, the Examiner had raised the issue during an Examiner Interview.

Applicants responded to the Examiner's inquiry in that previous application at pages 4-5 of an Amendment filed on February 21, 2003 by explaining that the terminology "groove track" and "land track" as used in that application has been generally used since the 1990's in the art of optical recording discs. Applicants referred to, for example, Fig. 1a of U.S. Patent No. 6,181,672 (a copy of which is attached hereto as Exhibit B) and the corresponding description in the

specification. Applicants went on to explain that there may be several reasons or explanations for this terminology. For instance, although the groove track may look as though it "protrudes" from the land track (as shown in FIGs. 1a and 2a of Exhibit B), in a manufacturing process of the recording disc, a transparent substrate is formed, at the first process step, so as to have grooves for tracks in one surface by molding the molten substrate material (e.g., plastic) onto a master disc or a stamper disc. In the next process step, a recording material is formed or deposited on the grooves to form groove tracks. Thus, Applicants respectfully submit that it became common to those skilled in this art to refer to the "protruding" track as a "groove track."

Moreover, Applicants respectfully submitted in that prior application that the terminology "groove track" and "land track" as used in that application is consistent with the manner generally used by those skilled in the art of optical recording discs. The filing of this response was followed by a Notice of Allowance that was issued in that prior application by Examiner A. Psitos on April 11, 2003. See Fig. 3 of that prior application, which issued as U.S. Patent No. 6,618,350 (attached hereto as Exhibit A) showing groove 12 and land 13.

Accordingly, for at least the foregoing reasons, Applicants respectfully traverse the objection and requirement for corrected drawings in the instant application. As a result, Applicants request that the objection and requirement for corrected drawings be withdrawn.

Rejections under 35 U.S.C. §§ 102(b) and 103(a)

Claims 1, 2, 12 and 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Noda. Claims 3 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Noda as applied to claims 1 and 12, and further in view of Iida. Claims 9 and 18 stand rejected under

35 U.S.C. § 103(a) as being unpatentable over Noda as applied to claims 1 and 12, and further in view of Alon. Claims 10, 11, 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Noda as applied to claims 1 and 12, and further in view of Imada.

The Office Action alleges that Noda discloses each element of independent claims 1 and 12, for example. The Office Action alleges that the features of independent claims 1 and 12 are disclosed in connection with Figs. 2, 6 and 7 of Noda. See pages 3-4 of the Office Action.

After careful consideration of the applied Noda reference, Applicants respectfully submit that the combinations currently recited in independent claims 1 and 12 of the instant application are not anticipated by Noda. The Office Action relies upon Fig. 6 of Noda in its assertion of anticipation of independent claims 1 and 12. However, Applicants respectfully submit that in Figure 6 of Noda, the diffraction grating 8 (shown in Fig. 2 of Noda) of the optical head creates five diffraction lights, namely, 0th order diffraction light, ±1st order diffraction lights and ±3rd order diffraction lights. In Fig. 6, these five diffraction lights become the five light spots 4, 5a, 5b, 5c and 5d (See Noda, column 3, lines 60-64). Noda explicitly indicates that the ±2nd order diffraction lights (i.e., light spots 5m and 5n) are not considered. In particular, at column 4, lines 1-5, Noda discloses that the ±2nd order diffraction lights (i.e., light spots 5m and 5n) "have no particular relation with the present invention" and that therefore "the explanation thereof will be omitted."

On the other hand, the embodiments recited in at least independent claims 1 and 12 of the instant application utilizes 0th order diffraction light, ±1st order diffraction lights and ±2nd order diffraction lights. Even assuming, strictly arguendo, that Fig. 6 of Noda could somehow be applied against the instant application, Applicants' claimed embodiments utilize the light spots 4,

5a, 5b, 5m and 5n. However, as discussed above, at least column 4, lines 1-5, Noda clearly teaches away from any suggestion of using the ±2nd order diffraction lights (i.e., light spots 5m and 5n) in combinations as recited in the claims of the instant application by explicitly noting that the ±2nd order diffraction lights (i.e., light spots 5m and 5n) "have no particular relation with the present invention" and that therefore "the explanation thereof will be omitted." Therefore, Applicants respectfully submit that Noda does not show, or even suggest, Applicants' recited combinations and thus cannot anticipate the claimed embodiments of the invention.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. §§ 102(b) and 103(a) should be withdrawn because the applied art of record, whether taken singly or combined, do not teach or suggest each feature of independent claims 1 and 12. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Similarly, MPEP § 2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)."

Furthermore, Applicants respectfully assert that dependent claims 2-11 and 13-20 are allowable at least because of the dependence from their respective independent claims 1 or 12, the reasons set forth above, and because the applied secondary references to Iida, Alon and Imada fail to cure the deficiencies of Noda, as discussed above. The Examiner is thanked for the indication that dependent claims 4-8 and 15-17, while objected to as being dependent upon a

rejected base claim, would be allowable if rewritten in independent form. However, in light of the foregoing discussion, withdrawal of the objection to these claims is respectfully requested.

CONCLUSION

In view of the foregoing, Applicants respectfully request the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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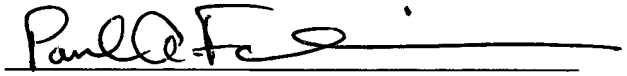
Dated: October 4, 2004 By: 

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